



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|---|-------------|----------------------|---------------------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/708,498 | 03/08/2004 | James D. Charasika | 439070100 | 2497 |
| 20322 7590 04/18/2007 SNELL & WILMER L.L.P. (Main) 400 EAST VAN BUREN ONE ARIZONA CENTER PHOENIX, AZ 85004-2202 | | | EXAMINER BATTULA, PRADEEP CHOUDARY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3722 | |

| | | |
|--|------------|---------------|
| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
| 3 MONTHS | 04/18/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/708,498

Applicant(s)

CHARASIKA, JAMES D.

Examiner

Pradeep C. Battula

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in reply to the response filed on January 24, 2007

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 2, and 4 – 12, 17 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldershof (U.S. 3,145,841) in view of Lewis (U.S. 1,024,731).

In regards to Claim 1, Aldershof discloses a system for selective collection of information comprising: a first complete information collection sheet 1a, including a first portion (Figure 4, Item 17') for collection of a first information and a second portion (Figure 4, Item 17') for collection of a second information (Column 4, Lines 23 – 36), said first portion (top portion of sheet 1a) including a first select information section (bottom portion of sheet 1a) (Figure 4, Item 17'); a second complete information collection sheet 1b underlying said first complete information collection sheet in overlapping position, wherein a top edge of said second complete information collection sheet is substantially aligned with a bottom edge of said first select information collection section of said first complete information collection sheet (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines), said second complete information collection sheet including a third portion (top portion of sheet 1b) for collection of a third information and a fourth portion (bottom portion of sheet 1b) for

Art Unit: 3722

collection of a fourth information (Column 4, Lines 23 – 36) said third portion including a second select information section.

With respect to select information sections examiner has designated areas of different indicia as presented by the reference. Furthermore, Aldershof discloses the above claimed subject matter except for the specific arrangement and/or content of indicia (select information) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (select information) and the substrate (overlapping sheets) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Aldershof does not disclose a reproduction enabling media underlying said first and second complete information collection sheets, said reproduction enabling media in

Art Unit: 3722

direct communication with said first and second select information section; and a record data sheet underlying said enabling media, said record data sheet in communication with said reproduction enabling media.

Lewis teaches of a reproduction media K associated with a record sheet associated with a record sheet underneath a secure document (Page 2, Lines 31 – 45; Figure 3, Item K) where select information is duplicated (Page 2, Lines 37 – 43).

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Lewis' teaching of a reproduction media existing in a particular area of interest in order to allow a user to have secure information with for recordation purposes in case of future forgery (Page 2, Lines 37 – 51).

Furthermore, select information locations require select information and select information is placed in particular areas and not all areas. Therefore when one is to place Lewis' reproduction media in select areas and that means only certain areas will be provided the reproduction media. Choosing select areas is only a decision requiring an arrangement of parts and therefore not critical and an obvious design choice. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

In regards to Claim 2, as applied to Claim 1, Aldershof modified by Lewis further discloses said first 1a and second 1b complete collection information sheets are individually removable with the first complete information collection sheet removable prior to the second complete collection information sheet being removable (Column 4, Lines 23 – 36; Figures 1, 4 of Aldershof).

Art Unit: 3722

In regards to Claim 4, as applied to Claim 1, Aldershof modified by Lewis discloses the claimed invention except for the specific arrangement and/or content of indicia (instructions) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with instructive indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (instructive indicia) and the substrate (overlapping sheets) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 5, as applied to Claim 4 and further disclosed in Claim 1, Aldershof modified by Lewis further discloses that information provided to said first select information section (Column 3, Lines 11 – 16 of Aldershof) is provided to said reproduction enabling media and information provided to said second portion is provided to said first complete information collection sheet.

Art Unit: 3722

In regards to Claim 6, as applied to Claim 5 and further disclosed in Claim 1, Aldershof modified by Lewis further discloses information provided to said second select information section is provided to said reproduction enabling media and information provided to said fourth portion (Column 4, Lines 23 – 36 of Aldershof) is provided to said second complete information collection sheet.

In regards to Claim 7, as applied to Claim 6 and further disclosed in Claim 1, Aldershof modified by Lewis further discloses said first complete information collection sheet is detached prior to providing the information to the second select information section (Column 4, Lines 35 – 50 of Aldershof).

Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In regards to Claim 8, as applied to Claim 5, Aldershof modified by Lewis further discloses said first select information section information is provided from said reproduction enabling media K to said record data sheet B,C in real-time (Page 2, Lines 44 – 51; Lewis).

In regards to Claim 9, as applied to Claim 8, Aldershof modified by Lewis further discloses said first select information section information is provided to said reproduction enabling media K in real-time (Page 2, Lines 44 – 51; Lewis).

In regards to Claim 10, as applied to Claim 8, Aldershof modified by Lewis discloses the claimed invention matter except for the specific arrangement and/or content of indicia (identifier) set forth in the claim(s). It has been held that when the

Art Unit: 3722

claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of identifier does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets with reproduction media comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (identifier) and the substrate (overlapping sheets and reproduction media) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 11, as applied to Claim 7, Aldershof modified by Lewis further discloses the second select information section information is provided from said reproduction enabling media to said record data sheet in real-time (Page 2, Lines 44 – 51; Lewis).

In regards to Claim 12, as applied to Claim 11, Aldershof modified by Lewis discloses the claimed invention matter except for the specific arrangement and/or content of indicia (identifier) set forth in the claim(s). It has been held that when the

Art Unit: 3722

claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of identifier does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets with reproduction media comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (identifier) and the substrate (overlapping sheets and reproduction media) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 17, Aldershof discloses a method for select collection of information, comprising: using one of a plurality of complete information sheets (1a – 1d) to provide information (Figure 4), the plurality of complete information collection sheets being arranged in overlapping manner such that topmost sheet is obscuring a first portion of the next successive underlying sheet (Column 4, Lines 23 – 36). Further disclosed is that removing a topmost one of the plurality of complete collection sheets to

Art Unit: 3722

provide information to the next successive underlying sheet is required (Column 4, Lines 23 – 36; Figure 4).

Aldershof does not disclose the plurality of sheets further arranged such that a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media. Also not disclosed reproducing, on a record data sheet in real-time, information provided to the portion of each plurality of complete information collection sheets.

Lewis discloses a plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media K (Page 2, Lines 31 – 45; Figure 3, Item K) for reproducing the information provided to the portion of each sheet in contact with the media and reproducing, on a record data sheet B,C (Page 1, Lines 31 – 39, 59 – 60) in real-time information provided to the portion of each plurality of complete information collection sheets (Page 2, Lines 44 – 51; Lewis). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Lewis' teaching of a reproduction media existing in a particular area of interest in order to allow a user to have secure information with for recordation purposes in case of future forgery (Page 2, Lines 37 – 51; Lewis).

With this modification, the first sheet is filled out and has the information reproduced and then the user goes to the second sheet as disclosed in Aldershof and the process is repeated as disclosed by applicant.

In regards to the location of the reproducible media please refer to the explanation of Claims 1 and 13.

In regards to Claim 18, Aldershof discloses a method for select collection of information, comprising: arranging a plurality of sheets in an overlapping manner such that the topmost sheet is obscuring a first portion of the next successive underlying sheet of the plurality of sheets (Column 4, Lines 23 – 36).

Aldershof does not disclose arranging the plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media; and enabling the reproduction, in real-time on a record data sheet, information provided to the portion of each plurality of complete information collection sheets.

Lewis discloses a plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media K (Page 2, Lines 31 – 45; Figure 3, Item K) for reproducing the information provided to the portion of each sheet in contact with the media and enabling the reproduction, in real-time (Page 2, Lines 44 – 51; Lewis). on a record data sheet B,C (Page 1, Lines 31 – 39, 59 – 60), information provided to the portion of each plurality of complete information collection (Page 2, Lines 44 – 51; Lewis). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Lewis' teaching of a reproduction media existing in a particular area of interest in order to allow a user to have secure information with for recordation purposes in case of future forgery (Page 2, Lines 37 – 51; Lewis).

In regards to the location of the reproducible media please refer to the explanation of Claims 1 and 13 or the Response to Arguments below.

Art Unit: 3722

2. Claims 3, 13 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldershof in view of Lewis and Donovan.

In regards to Claim 3, as applied to Claim 1, Aldershof modified by Lewis further discloses the reproduction media and record sheet B,C (Page 1, Lines 31 – 39, 59 – 60) are detachably affixed to one another (Page 1, Lines 58 - 62).

Aldershof modified by Lewis does not disclose the reproduction media and record sheets well as to the documents from which the information is duplicated.

Donovan discloses reproduction media (not numbered) and record sheet 662 are detachably affixed to one another as well as to the documents from which the information is duplicated (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10 of Donovan). Therefore it would have been obvious to a person having ordinary skill in the art to provide the reproduction media on separate sheets because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

In regards to Claim 13, Aldershof discloses a system for selective collection of information comprising: a plurality of complete information collection sheets stacked in overlapping manner (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines), wherein each one of said plurality of complete information sheets includes a first portion (bottom portion of sheet 1a) for collection of select information and a second portion (top portion of sheet 1a) for collection of nonselective information (Column 4, Lines 23 – 36; Figure 4). Further disclosed is said plurality of complete information collection sheets positioned such that a top edge of each underlying one of

Art Unit: 3722

said plurality of complete information collection sheets is substantially aligned with the bottom edge of the first portion of the next preceding overlying one of said plurality of complete information collection sheets, said plurality of complete collection sheets (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines).

Aldershof does not disclose a reproduction enabling media underlying said plurality of complete information collection sheets, said reproduction enabling media in contact with said first portion of each one of said plurality of complete information collection sheets; and a record data sheet underlying said reproduction enabling media. Also not disclosed is the reproduction enabling media and record data sheets being immovably positioned one to the other.

Lewis teaches of a reproduction media K associated with a record sheet B,C (Page 1, Lines 31 – 39, 59 – 60) underneath a secure document (Page 2, Lines 31 – 45; Figure 3, Item K). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Lewis' teaching of a reproduction media existing in a particular area of interest in order to allow a user to have secure information with for recordation purposes in case of future forgery (Page 2, Lines 37 – 51).

Aldershof modified by Lewis does not disclose that the reproduction enabling media and record data sheets being immovably positioned one to the other

Donovan teaches of a reproduction enabling media (not numbered) and record data sheets 666 being immovably positioned one to the other (Column 14, Lines 1 – 5). Therefore it would have been obvious to a person having ordinary skill in the art at the

Art Unit: 3722

time the invention was made to use Donovan's reproduction media and record sheet in the select information locations of Aldershof's invention in order to allow for one to have select information in a permanent record with minimal amount of extra material (Column 13, Lines 64 – 68).

Furthermore, select information locations require select information and select information is placed in particular areas and not all areas. Therefore when one is to place Donovan's reproduction media in select areas and that means only certain areas will be provided the reproduction media. Choosing select areas is only a decision requiring an arrangement of parts and therefore not critical and an obvious design choice. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

In regards to Claim 14, as applied to Claim 13, Aldershof modified by Lewis and Donovan further discloses that each one of the plurality of complete information collection sheets is individually detachable from the remaining sheets (Column 4, Lines 23 – 36; Figures 1, 4; Aldershof).

In regards to Claim 15, as applied to Claim 14, Aldershof modified by Lewis and Donovan further discloses information provided to said first portion is provided to said reproduction enabling media (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10; Donovan; Please review the Claim 13 rejection regarding position of select information locations and reproduction media).

Furthermore, Aldershof modified by Lewis and Donovan discloses the claimed invention except for the specific arrangement and/or content of indicia (instructions) set forth in the claim(s). It has been held that when the claimed printed matter is not

Art Unit: 3722

functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with instructive indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (instructive indicia) and the substrate (overlapping sheets) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 16, as applied to Claim 15, Aldershof modified by Donovan further discloses said first portion includes instructions for providing information to said first portion, said information provided to said first portion is provided to said reproduction enabling media (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10; Donovan).

Response to Arguments

Applicant's arguments with respect to Claims 1 – 18 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3722

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
April 11, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER